REMARKS

Claims 21-43 are all the claims pending in the application. Applicants have amended

independent claims 21 and 30 to recite more specifically the structure and operation of two

separate participant listings. In addition, Applicants have made other conforming and technical

amendments to claims 22, 24, 26, 27, 29, 30-32, 34-36 and 41-43. Claim 25 has been cancelled.

CLAIM REJECTIONS - 35 U.S.C. § 103

In the office action dated July 1, 2005, the Examiner rejected all the claims as follows:

Claims 21-43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over

Baumgartner et al (U.S. Patent 5,195,086), and further in view of Marshak

"BeyondMail for Windows," Rangan et al "Software Architecture for Integration

of Video Services in the Etherphone System," and IBM TDB0992 "Public

Nicknames in OS2 Office Address Book.".

The Examiner asserts that Baumgartner, Marshak and Rangan et al may be combined to

provide a teleconferencing system with a directory system, recognizing that Baumgartner does

not teach a first and second directory. The Examiner asserts that it would be obvious to adapt the

public and private address book feature from the Marshak email system (page 4) to the directory

illustrated in Baumgartner in Fig. 18 and disclosed at col. 18-19. The Examiner admits that

Baumgartner does not concern (1) video or video capture capabilities or (2) a rolodex-like

functionality, but asserts at page 5 of the Office action that a modification of Baumgartner to

include video capture capabilities would be obvious in view of the teachings of multi-media

conferencing in Rangan and the modification of that combination to provide a rolodex capability

for a video-type collaboration system would be obvious in view of the address book feature for

an email system that is mentioned in Marshak. Nonetheless, the Examiner admits that even this

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combination of three references from diverse systems (email and conferencing) would not disclose how the directories in the Examiner's system would be populated.

Thus, the Examiner cites IBM TDB0992 "Public Nicknames in OS2 Office Address Book." Specifically, as explained at page 4 of the Office Action, the IBM reference is cited to remedy the admitted deficiencies in Marshak with respect to the use of a second private directory that is made by copying fewer than all entries from a common directory. The IBM reference concerns a "Nickname" feature of the OS-2 operating system, and the Examiner asserts that the reference mentions the use of two directories and the ability to populate the private address book with entry from the public address book, with reference to page 2, second full paragraph lines 1-2 and 9-12. The Examiner also looks to IBM reference for a teaching of a "drag and drop" technique for adding entries to a private directory, as asserted at page 7 of the Office Action.

RESPONSE TO CLAIM REJECTIONS

In response, Applicants have amended the claims and present the following arguments in support of patentability of the amended claims.

1. The claimed invention

The present invention provides a unique directory and call management capability to video display devices in a teleconference system, particularly one with plural user terminals, each having video display capability. As illustrated in Fig. 20, each user terminal has the capability to provide both a rolodex-type access to a directory of addresses as well as a quick dial access to another directory. This dual display capability offers significant advantages and convenience not found in the prior art.

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The dual directory display is illustrated in Fig. 2A and shows both a rolodex type listing of only names, that is accompanied by displayable detailed information that is coupled into the directory, and a quick dial access. The quick dial access is provided through an assembly of icons that are displayed on a user terminal display, as illustrated in several figures, including Figs. 2A, 2B, 8C, 22 and 35-42. The convenience of having both the rolodex directory, supplemented optionally by a display of addressee detail, and the quick dial directory of icons is readily apparent from the foregoing illustrations. The icons are may be established by dragging entries from a rolodex onto the quick dial assembly display.

As also explained at pages 31-32 and elsewhere in the application with regard to working examples (see also cols. 18 and 19 of USP 6,237,025), a collaborative session may be established in one or two steps using either the rolodex directory or the quick-dial feature. In a two step process, a user may select a desired participant by clicking a name on the rolodex or by clicking on the appropriate displayed quick dial button, and then selecting the desired session by clicking on another appropriate button for a teleconference, mail, etc. In a one step process, a session type is defined by default, and a double clicking on a name in a rolodex or quick dial button will establish the collaborative session.

The claims have been amended to focus on, and now recite, all of the foregoing features, particularly with respect to independent apparatus claim 21 and independent method claim 30. As shown below, this claimed combination differs from the prior art cited by the Examiner as it has features that are not taught, suggested or obvious from the prior art.

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2.   **The prior art references, either alone or in combination do not teach or suggest all the claimed limitations**

As the Examiner is aware, to "establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (*MPEP 2143.03*)

As shown below, this *prima facie* case cannot be made because a number of claim elements are not taught or suggested by the prior art.

A.   *The prior art does not teach or suggest two separate participant listings, displayed to a call originating participant, where the information in one listing is copied from the other directory but is of a different type.*

More specifically, the independent claims are limited to a teleconference system and method adapted to serve situations where

- o   two listings of participants -- a graphical rolodex and a quick dial list – are displayed to participant, as opposed to an administrator; and

- o   the quick dial list is created by copying from the rolodex; and

- o   even for the same listed participant, the displayed content – rolodex vs. icons – is different in the two lists.

The Examiner has noted that Baumgartner's directory includes icons, but, as the Examiner also admits, there is only one directory. Thus, Baumgartner does not and cannot contemplate the provision of two directories with different displayable content, the display of

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two directories with different content, or the copying of content between directories. Similarly, while the Examiner reasons that Marshak and the IBM TDB0992 disclose two directories, they do not disclose icons. Indeed, there is no teaching or suggestion that the directories would have different content. To the contrary, the content is the same, based on the use of a common template.

Thus, the prior art does not disclose this claim limitation.

B.   *The prior art does not teach or suggest that there are two ways in which communication of a defined type can occur using the two directories, and that these occur automatically.*

More specifically, the independent claims are limited to situations where collaboration

- o is initiated when an initiating participant selects another participant listed in at least one of the graphical rolodex and quick dial list, and

- o is established automatically in "one of a plurality of communication types" either when the initiating selects a communication type or, in other circumstances, by default when the participant is selected.

Automatically establishing a collaboration event of a defined type is a clearly recognized feature of this invention that has been recognized as not taught by the prior art.

For example, as pointed out by Appellant in the Appeal Brief in this RCE application's predecessor, "contrary to the directory feature of the present invention, in order to initiate a video conference in the Rangan system, a caller must embark on a complex multi-step procedure"[1]

The Appeal Board agreed, stating "Appellants argue that Rangan teaches no directories and hardly allows for rapid teleconferencing connection set-up....While we *agree with appellants...*"[2]

Similarly, and unsurprisingly, the Appeal Board's opinion suggests that claim limitations directed at "users [being] able to select participants in real time easily and quickly hiding the complex details of multichannel multimedia connection set up"[3] would differentiate the claims from Marshak. By extension, this would also differentiate the claims from the IBM TDB as well.

CONCLUSION

In short, Applicants have now narrowed the claims and have defined the invention with significant detail such that the invention is patentable over the prior art.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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[1] Appeal Brief at page 5.

[2] Opinion at page 9.

[3] Opinion at the bottom of page 10 and top of page 11.

Amendment under 37 C.F.R. § 1.111
Application No. 09/702,737

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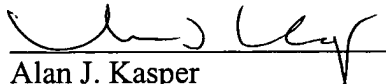
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Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (650) 625-8100
Facsimile: (650) 625-8110

Alan J. Kasper
Registration No. 25,426

MOUNTAIN VIEW OFFICE
23493
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